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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,497	07/02/2003	Tientch Chen	200309844-1	9905

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EXAMINER

SHEWAREGED, BETELHEM

ART UNIT	PAPER NUMBER
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1774

MAIL DATE	DELIVERY MODE
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06/07/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/613,497	CHEN, TIENTEH	
	Examiner	Art Unit	
	Betelhem Shewareged	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's response along with the Request for Continued Examination (RCE) filed on 03/28/2007 has been fully considered. Claims 1 and 8 are amended, claims 11-20 are canceled, and claims 1-10 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification and/or the original set of claims do not provide a support for the newly added limitation. The specification discloses that the hydrophilic polymer may be used **to bind** the components of the ink receiving layer [0016]. According to the specification in [0016], the binder is used to bind all the components **not** just selected components. If there is a support for the newly add limitation, Applicant is advised to redirect the Examiner to the proper area in the specification.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sismondi et al. (US 6,387,473 B1) in view of Li (US 6,183,844 B1).

6. Sismondi discloses an ink jet receiving sheet comprising a support and ink receiving layers on the support (abstract). The support is described on col. 4, line 30. The ink receiving layers comprise a non-ionic surfactant (col. 3, line 31 thru col. 4, line 29), a binder (col. 5, line 63 thru col. 6, line 48), inorganic particles (col. 7, line 11 thru col. 24), an additional surfactant (col. 7, line 43 thru col. 61), a mordant (col. 7, line 62 thru col. 8, line 61), and a hardener (col. 8, line 63 thru col. 9, line 17). The ink receiving layers further comprise glossiness improving agents, matting agents, a plasticizer, biocides and conventional additives; however, these additional components are added to improve the pictorial or physical properties of the image. Sismondi does not disclose the use of siloxane containing surfactant as the non-ionic surfactant.

7. Sismondi discloses the claimed invention except the non-ionic siloxane containing surfactant. Li shows that a non-ionic surfactant by a trade name Silwet is equivalent to non-ionic surfactants by trade names Fluorad and Triton (col. 16, line 61 thru col. 17, line 4). Therefore, because these non-ionic surfactants were art recognized equivalents at the time the invention was made, one of ordinary skill in the

Art Unit: 1774

art would have been found it obvious to substitute non-ionic surfactant by trade Names Fluorad or Triton for non-ionic surfactant by a trade name Silwet.

Response to Arguments

8. As discussed above there is no support for the newly added limitation, even if there is a support, one of the general purposes of the binder in the ink jet recording medium art is to bind the components in a layer. The Examiner interprets "surfactant is considered not to be a part of the film forming organic polymer" of Li as ---the surfactant is a component that is mixed before coating and/or drying. It is also interpreted as ---the surfactant is not chemically reacted with the organic polymer primarily. The surfactant of Li, among other components, is admixed with the organic polymer, and then the mixture is coated followed by drying to form the layer (col. 17, lines 27-55). In this case, one of the general purposes of the organic polymer is to bind the components together. The following references can be used as evidence to show such general teaching. See col. 3, line 29 of Ohmura et al. (US 5,863,648) and paragraph [0020] of Kasperchik et al. (US 2004/0066439 A1). For the above reason claims 1-10 stand rejected.

Conclusion


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 571-272-1529. The examiner can normally be reached on Mon.-Fri. 8:00AM-4:30PM.

Art Unit: 1774

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BS
May 31, 2007.


BETELHEM SHEWAREGED
PRIMARY EXAMINER